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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.														
10/822,920	04/13/2004	Eric Zitaner	52531.100001 (CON)	3562														
7590 W. Scott Petty, Esq. KING & SPALDING LLP 45th Floor 191 Peachtree Street, N.E. Atlanta, GA 30303		06/13/2007	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">WONG, LESLIE</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>2164</td><td></td></tr><tr><td colspan="2"><table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>06/13/2007</td><td>PAPER</td></tr></table></td></tr></table>		EXAMINER		WONG, LESLIE		ART UNIT	PAPER NUMBER	2164		<table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>06/13/2007</td><td>PAPER</td></tr></table>		MAIL DATE	DELIVERY MODE	06/13/2007	PAPER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/822,920

Applicant(s)

ZITANER ET AL.

Examiner

Leslie Wong

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 20 March 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,741,993 B1 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Withdrawal of 112 and 101 Rejections***

2. Applicants' amendments overcome the 112 and 101 rejections raised in Office Action, dated 11 December 2007. Accordingly, the above-mentioned rejections are hereby withdrawn by the Examiner.

### ***Claim Rejections - 35 USC § 103***

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 17-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Havens** (US 5924072 A) in view of **Parsons** (US 6411939 B1) and further in view of **Tremaine** (US 5819231 A).

Regarding claim 17, **Havens** teaches a competitive rewards database system (i.e., database 30 in Fig. 1; col. 9, line 29 – col. 10, line 24) comprising:

- a). a competitive reward database operative to receive raw competitive rewards data comprising competitive rewards data for employees of an entity and (col. 6, line 62 – col. 7, line 1; col. 7, lines 13-22);
- c). a computer system, coupled to the competitive rewards database via data communications channel, operative to provide the competitive rewards data for employees of the entity to the competitive rewards database on behalf of the entity (col. 3, lines 19-22 and 30-35), and
- d). a rewards workbench operable to query the competitive rewards database in support of analysis (col. 7, lines 13-22).

**Havens** does not explicitly teach the steps of:

- a). receiving competitive rewards data from a plurality of sources other than the entity.
- b). data mapping table for automatically mapping the raw competitive rewards data prior to incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline or scope.

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**Parsons**, however, teaches the step of:

- a). receiving competitive rewards data from a plurality of sources other than the entity (col. 11, lines 40-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Parsons'** teaching would have allowed **Havens'** to provide due diligence on the replacement plan by preparing a comparative study for providing compliance information on the benefits as suggested by **Parsons** col. 11, lines 47-60.

**Havens and Parsons** do not explicitly teach the steps of:

- b). data mapping table for automatically mapping the raw competitive rewards data prior to incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline or scope;
- d). the mapped competitive rewards data.

**Tremaine**, however, teaches the steps of:

data mapping table for automatically mapping the raw competitive rewards data prior to incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline or scope as the job code file 26 may include a listing of one or more job codes 75 and their corresponding titles 76... For each job code, the job code file 26 may

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also include a salary guideline and a total compensation guideline 80 (col. 5, lines 5-15).

d). the mapped competitive rewards data (Fig. 3A).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Tremaine's** teaching would have allowed **Havens- Parsons'** to provide compensation planning which determine the salary and bonuses paid to each employee by month or the combined salary and bonuses paid to the employees as suggested by **Tremaine** col. 9, lines 62-66.

Regarding claims 18, 25, and 38, **Havens** further teaches wherein the competitive rewards data for the entity comprises employment data for the employees of the entity, the employment data comprising at least one of base pay data, long term incentive pay data and annual incentive pay data (col. 6, lines 35-43).

Regarding claim 19, **Havens** further teaches wherein the competitive rewards data contains at least one calculated data value (col. 6, lines 44-53).

Regarding claims 20-21, **Havens** further teaches a data capture tool operable to provide remote access to at least a portion of the competitive rewards database and wherein the rewards workbench is coupled to a data network and is operable to provide

remote access to at least a portion of the competitive rewards database (col. 4, lines 9-31 and Fig. 1).

Regarding claims 22, 24, and 39, **Parsons** further teaches wherein the rewards workbench is operable to automate data feeds from the competitive rewards database to at least one third party human resources management system (col. 28, lines 10-15).

Regarding claims 23 and 37, **Havens** teaches method for administering a competitive rewards database comprising:

- a). receiving raw competitive rewards data comprising competitive rewards data for employees of an entity (col. 4, lines 32-51, col. 9, line 29 – col. 10, line 14);
- c). incorporating the mapped competitive rewards data into the records of the competitive rewards database (col. 5, lines 36-47 and col. 8, lines 18-63); and
- d). analyzing the mapped competitive rewards data by performing a competitive rewards analysis for one or more of the employees of the entity (col. 11, lines 21-45; col. 7, lines 13-22).
- e). generating a report presenting results of the analysis (col. 7, lines 13-22).

**Havens** does not explicitly teach the steps of:

- a). receiving competitive rewards data from a plurality of sources other than the entity.
- b). automatically mapping the raw competitive rewards data for incorporation into the competitive rewards database by mapping the raw

competitive rewards data to benchmarks comprising job function, discipline, or scope.

**Parsons**, however, teaches the step of:

- a). receiving competitive rewards data from a plurality of sources other than the entity (col. 11, lines 40-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Parsons'** teaching would have allowed **Havens'** to provide due diligence on the replacement plan by preparing a comparative study for providing compliance information on the benefits as suggested by **Parsons** col. 11, lines 47-60.

**Havens and Parsons** do not explicitly teach the step of:

- b). automatically mapping the raw competitive rewards data for incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline, or scope;

**Tremaine**, however, teaches the steps of:

automatically mapping the raw competitive rewards data prior to incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline or scope as the job code file 26 may include a listing of one or more job codes 75 and their corresponding titles 76... For each job code, the job code file 26 may



also include a salary guideline and a total compensation guideline 80 (col. 5, lines 5-15).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Tremaine's** teaching would have allowed **Havens- Parsons'** to provide compensation planning which determine the salary and bonuses paid to each employee by month or the combined salary and bonuses paid to the employees as suggested by **Tremaine** col. 9, lines 62-66.

Regarding claim 26, **Havens** further teaches wherein the step of mapping the raw competitive rewards data comprises translating, scaling, reformatting or calculating portions of the raw competitive rewards data for compatibility with the benchmarks (col. 3, line 59 – col. 4, line 20).

Regarding claim 27, **Havens** further teaches the step of using a data capture tool to adjust the mapping of the raw competitive rewards data (col. 4, lines 9-31).

Regarding claims 28 and 40, **Havens** further teaches the step of using a rewards workbench to query the competitive rewards database in support of analyses of the mapped competitive rewards data, the analyses comprising at least one selected from a group comprising evaluation of prevalence of reward practices and plan provisions, comparison of member reward values to specific comparator groups, development of

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market reference data, model and development of base pay structure, analyses of competitive rewards cost implications, and data mining analyses (col. 7, lines 13-22; col. 3, lines 1-5; and col. 6, lines 5-9).

Regarding claims 29 and 41, **Tremaine** further teaches the step of using a rewards workbench to automate a data feed between the competitive rewards database (col. 4, lines 25-31).

**Parsons** at least one third party human resources management system that is not associated with the entity, thereby supporting a submission of certain mapped competitive rewards data in the form of a survey to the third party human resources management system (col. 37, lines 16-21)

Regarding claims 30 and 42, **Havens** further teaches wherein the step of analyzing the mapped competitive rewards data comprises a competitive rewards analysis, a total compensation planning analysis or a performance-based analysis (col. 7, lines 13-22).

Regarding claims 31 and 43, **Havens** further teaches wherein the step of receiving the raw competitive rewards data comprises receiving the raw competitive rewards data at the competitive rewards database on a periodic basis (col. 7, lines 13-31 and col. 8, lines 12-32).

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Regarding claims 32 and 44, **Havens** further teaches wherein the step of receiving the raw competitive rewards data comprises:

sending a polling signal from the competitive rewards database to a computer system operated on behalf of the entity (col. 8, lines 12-32); and

responsive to the polling signal, transmitting the competitive rewards data for the employees of the entity from the computer system to the competitive rewards database (col. 8, lines 12-32).

Regarding claims 33 and 45, **Havens** further teaches wherein the data mapping step comprises using a data mapping table to map without manual intervention the raw competitive reward data (col. 5, lines 19-31).

**Havens** does not explicitly teach competitive reward data based on benchmark global job matches.

**Parsons**, however, teaches competitive reward data based on benchmark global job matches (col. 2, lines 41-51; col. 3, lines 10-15; col. 4, lines 17-19; and col. 37, lines 54-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Parsons'** teaching would have allowed **Havens'** to provide cross-border solution for implementing the compensation/benefit plans as suggested by **Parsons** col. 2, lines 45-51.

Regarding claim 34, **Havens** further teaches the step of generating a report in response to completing the analysis of the competitive rewards data (col. 7, lines 13-22).

Regarding claim 35, **Havens** further teaches wherein the step of analyzing the mapped competitive rewards data generates an up-to-date mapping for competitive rewards data of the employees for the entity to at least one of the benchmarks (col. 13, lines 12-20).

Regarding claims 36 and 46, **Havens** further teaches wherein the step of analyzing the mapped competitive rewards data comprises a comparison of the competitive rewards data for the employees of the entity to one of the benchmarks maintained by the competitive rewards database (col. 14, lines 30-65).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-46 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue that Havens does not disclose or suggest storing raw competitive data for employees of an entity and source other than the entity. In response to the preceding arguments, Examiner respectfully submits that claim 18 recites that "... the competitive rewards data for the entity comprises **employment data**

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for the employees of the entity, the employment data comprising at least one of base pay data, long term incentive pay data and annual incentive pay data.” Havens teaches storing raw competitive data as incentives may include any acknowledgments, commendations, tangible or intangible rewards, incentive credits for accumulations ...col. 6, lines 38-46. As such, Havens teaches storing raw competitive data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (571) 272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES RONES can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read 'Leslie Wong', with a long horizontal flourish extending to the right.

Leslie Wong  
Primary Patent Examiner  
Art Unit 2164

LW  
June 3, 2007